

Patent No. 6,175,957, and claims 44-45 in the context of O'Donnell '369 and Agesen's U.S. Patent No. 6,175,957.

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A. O'Donnell '369 does not anticipate claim 1

Claim 1 recites as follows:

1. A method, comprising:

while executing a program on a computer, detecting the occurrence of profileable events occurring in the instruction pipeline, and directing the instruction pipeline to record profile information describing the profileable events essentially concurrently with the occurrence of the profileable events, the detecting and recording occurring under control of hardware of the computer without software intervention.

In contrast, the portions of O'Donnell '369 indicated by the Office Action expressly teach that the “detecting and recording” of profileable events is performed by finite state automaton software. For example:

- O'Donnell's Abstract states that “recording” is performed by “analysis code.” “Code” is software.
- At col. 7, lines 34-42, O'Donnell states that the profiling “observer” (corresponding roughly to the “detecting” of the claim) is implemented by “profiling software,” and that this software can be run on multiple hardware platforms. If the profiling were performed by hardware as recited in the claim, it could not be used “in a cross-platform development environment,” as O'Donnell '369 states at col. 7, line 43, or “on any hardware/operating system platform,” as O'Donnell '369 states at col. 8, lines 1-5. O'Donnell's cross-platform “observer” can only be portable because it is software.
- At col. 9, lines 39-40, O'Donnell expressly states that “event management” (corresponding roughly to the “detecting and recording” of the claim) is not the responsibility of hardware.

O'Donnell '369 mentions some hardware features at col. 9, lines 38-40, but O'Donnell states no more than that his “observer” software, like any other software, requires some hardware in order to run. The indicated portions of O'Donnell '369 never state that this hardware is used for “detecting and recording” profileable events.

Claim 1 is not anticipated by O'Donnell '369. Claim 24 recites similar limitations and is patentable for similar reasons.

B. The Office Action is too incomplete to raise a rejection of claims 1 and 24

The Office Action writes that “recording occurring under control of hardware without software intervention” is “inherent.” Action of 12/30/02, page 3, line 11-12; page 8, lines 8-9. Reliance on “inherency” is governed by MPEP § 2112:

2112 Requirements of Rejection Based on Inherency; Burden of Proof

...

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. ...

“To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” ...

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” ... The Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency.

MPEP § 2112 instructs that a rejection may not rely on “inherency” without further explanation. Any rejection that relies on inherency must set out some “basis in fact and/or technical reasoning” to show that there is no other possible reading of the reference. In contrast, the Office Action’s discussion of claims 1 and 24 merely states that a certain fact is inherent, without any explanation of why that fact even might be true, let alone must be true.

The rejections of claims 1 and 24 are all formally incomplete, and therefore void *ab initio* and of no effect. The consideration of the other claims share this defect. No claim is rejected.

III. Dependent claims

A. Claims 2-23 and 25-45 are patentable with claims 1 and 24

Dependent claims 2-23 and 25-45 are patentable with the independent claims discussed above. In addition, the dependent claims recite additional features that further distinguish the art.

B. The Office Action fails to explain the “pertinence” of the reference

37 C.F.R. § 1.104(c)(2) reads as follows:

“When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.”

Rule 104(c)(2) raises two separate requirements, that the “particular part” of the reference be designated, and that the “pertinence … must be clearly explained.” *Ex parte Gambogi*, 62 USPQ 1209, 1213 (Bd. Pat. App. & Interf. 2002) (“It is not an applicant’s responsibility to set out a clear and concise rejection … setting out a rejection is the responsibility of the examiner”).

The Office Action merely “designates” portions relied on. However, the Office Action offers almost no explanation of “pertinence” to any claim limitation.

For example, there is no explanation of the pertinence of O’Donnell ’369 to the “last byte” limitation of claim 2. The Action merely “designates” col. 15, lines 17-62, where O’Donnell discusses the time at which profiling “starts” and “stops.” The pertinence of a time period to an address is not “apparent,” and the Office Action does not “clearly explain” that pertinence. Without such an explanation of “pertinence,” claim 2 is not rejected.

As another example, claims 5 and 27 recite that certain actions are performed on the “general registers of the computer.” The Office Action “designates” Abstract lines 4-8, col. 2 lines 63-67, col. 3 lines 1-5 and col. 16, lines 22-27. However, none of these sections mention “general registers,” and the pertinence is not apparent. Without an explanation of “pertinence,” claims 5 and 27 are not rejected.

The pertinence of the reference to a number of other claim limitations is similarly not apparent and not clearly explained. Applicant requests that any future Office Action clearly explain the pertinence of any reference cited against any limitation where a reasonable applicant could have a reasonable question.

IV. Conclusion

In view of the amendments and remarks, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. Enclosed is Petition for Extension of Time

This Information Disclosure Statement is being filed more than three months after filing of this application and after the mailing of a first Office Action on the merits, but before the mailing date of a final action under 37 C.F.R. § 1.113, or a Notice of Allowance under 37 C.F.R. § 1.311 (where there has been no prior final action), or an action that otherwise closes prosecution in the application. A fee is due pursuant to 37 C.F.R. §1.97(c)(2).

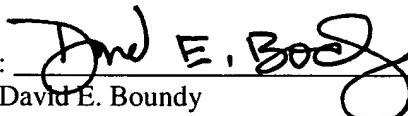
A check in the amount of \$ 180.00 is enclosed in payment of the fee due under C.F.R. §1.17(i)(1).

The Commissioner is hereby authorized to charge any additional fees that may be required for this Information Disclosure Statement, or credit any overpayment, to Deposit Account 50-0675, Order No. 5231/10-4017.

Respectfully submitted,

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Dated: April 30, 2003

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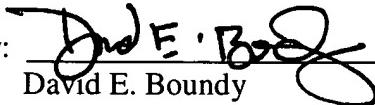
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for one month. In the event that any further extension of time is required, Applicant petitions for that extension of time required to make this response timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account 50-0675, Order No. 5231/10-4017.

Respectfully submitted,

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